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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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09/208,097

11/16/1998

JOHN S. HENDRICKS

5213

7677

38598

7590

07/02/2004

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EXAMINER

KOENIG, ANDREW Y

ART UNIT

PAPER NUMBER

2611

27

DATE MAILED: 07/02/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/208,097

Applicant(s)

HENDRICKS ET AL.

Examiner

Andrew Y Koenig

Art Unit

2611

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 19 April 2004.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) See Continuation Sheet is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☒ Claim(s) 1-20,23-30,34,35,38-90,93-97,101-112,116,119-122,124,125 and 127-129 is/are allowed.
- 6) ☒ Claim(s) 117 and 118 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____.
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____.

Continuation of Disposition of Claims: Claims pending in the application are 1-20,23-30,34,35,38-90,93-97,101-112,116-122,124,125 and 127-129.

DETAILED ACTION

Response to Arguments

1. Applicant's arguments filed 19 April 2004 have been fully considered but they are not completely persuasive. The applicant argues that there is support in parent applications for claims 117 and 118, which recite wherein the subscription includes on-line services and data services, respectively. Whereas, the applicant indicates in the parent applications disclosure supporting on-line services and data services, the parent applications fail to support a subscription for these services. A subscription is more than merely receiving a service, specifically a subscription, as defined by Webster's dictionary is: 3: *an arrangement for providing, receiving, or making use of something of a continuing or periodic nature on a pre-payment plan as a: a purchase by prepayment for a certain number of issues (as of a periodical) b: application to purchase securities of a new issue c: a method of offering or presenting a series of public performances d: Brit: membership dues.*

Allowable Subject Matter

2. Claims 1-20, 23-30, 34, 35, 38-90, 93-97, 101-112, 116, 119-122, 124, 125, and 127-129 are allowed.
3. The following is an examiner's statement of reasons for allowance:
4. Regarding independent claims 1, 34, 38, 62, 87, 108, 119, and 127, prior art of record fails to show or reasonable suggest programming filtered into a database and indexed by the number of times each program is purchased or a buy time.

Any comments considered necessary by applicant must be submitted no later than the payment of the issue fee and, to avoid processing delays, should preferably accompany the issue fee. Such submissions should be clearly labeled "Comments on Statement of Reasons for Allowance."

Priority

5. Applicant has not complied with one or more conditions for receiving the benefit of an earlier filing date under 35 U.S.C. 120 as follows:

The later-filed application must be an application for a patent for an invention which is also disclosed in the prior application (the parent or original nonprovisional application or provisional application); the disclosure of the invention in the parent application and in the later-filed application must be sufficient to comply with the requirements of the first paragraph of 35 U.S.C. 112. See *Transco Products, Inc. v. Performance Contracting, Inc.*, 38 F.3d 551, 32 USPQ2d 1077 (Fed. Cir. 1994).

This application repeats a substantial portion of prior Application No. 08/912,934 filed 15 August 1997, and adds and claims additional disclosure not presented in the prior application. Since this application names an inventor or inventors named in the prior application, it may constitute a continuation-in-part of the prior application. Should applicant desire to obtain the benefit of the filing date of the prior application, attention is directed to 35 U.S.C. 120 and 37 CFR 1.78.

Specifically, claims 117 and 118 recite the limitations of a subscription including on-line services and data services. The parent applications fail to recite the claimed

limitations; accordingly, claims 117 and 118 will be treated as claims filed 16 November 1998 (the filing date of the instant application).

Claim Rejections - 35 USC § 103

6. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

7. Claims 117 and 118 are rejected under 35 U.S.C. 103(a) as being unpatentable over U.S. Patent 6,463,585 to Hendricks et al. in view of U.S. Patent 6,105,060 to Rothblatt.

Regarding claims 117 and 118, Hendricks clearly teaches the limitations of claims 108 and 109.

Further regarding claims 117 and 118, the parent application fails to support the limitations addressed these claims. Accordingly, the effective date of the claims is 03 November 1998. Hendricks teaches online and data services but is silent on subscription for online and data services. Rothblatt teaches monthly subscriptions for accessing the Internet/WWW, which equates to online and data services (col. 17, ll. 4-24). Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to modify Hendricks by receive online and data subscriptions as taught by Rothblatt in order to provide the user with requested information thereby enabling the user to access more information conveniently.

Conclusion

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Andrew Y Koenig whose telephone number is (703) 306-0399. The examiner can normally be reached on M-Th (7:30 - 6:30).

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Andrew Faile can be reached on (703) 305-4380. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

ayk



**VIVEK SRIVASTAVA
PRIMARY EXAMINER**